

**Remarks:**

These remarks are responsive to the final Office action dated July 26, 2005. As noted in the present Office action, claims 1-14, 16 and 17 remain pending in the present application. Claim 9 has been allowed. Claims 1-8, 12-14 and 16-17 stand rejected under 35 USC §103(a) based on Endo et al. (US 5,894,318) in view of Hooper et al. (US 6,816,686). Claims 10-11 stand rejected under 35 USC §103(a) based on Endo et al. in view of Hooper et al. and Fukushima.

**Formal Matters**

First considering formal matters, applicants note that the Examiner cites "Fukushima" in rejecting claims 10-11, but does not specify Fukushima in any PTO-892 form, nor is it specified in any PTO-1492 form provided by applicants.

Applicants assume that "Fukushima" refers to US Patent No. 6,516,178 to Fukushima, but ask that the Examiner verify this. Applicants also ask that Fukushima (US 6,516,178) be properly listed in a PTO-892 form, and that it be cited on the face of any patent that issues from this application.

Applicants suggest that the Office has not met its obligation to cite US patents by patent number, patent date, name of patentee, class and subclass, as set forth in MPEP 707.05(e). Finality of the present Office action thus should be withdrawn. Applicants also note the Examiner's obligation to issue a correction letter, and to provide a corrected or new PTO-892 form, as set forth in MPEP 707.05(g).

**Drawings**

In the Office action, the drawings are objected to under 37 CFR 1.83(a) as failing to show the "automatic feed tray" and the "alternative bypass path". The Examiner asserts that these features "must be shown or the features cancelled from

Page 7 - AMENDMENT  
Serial No. 10/763,352  
HP Docket No. 200209331-1  
KH Docket No. HPCS 327

the claims." The Examiner does not specify where these features are found in the claims.

Based on applicants' review of the claims, it appears that the Examiner is referring to claims 9 and 13. Claim 9 recites "receiving the media sheet and at least one laminate material sheet from an automatic feed tray of the printing device." Claim 13 recites "a selectively operable bypass of the image-transfer mechanism." Both claims include language originally present in the claims (claim 13 incorporates language from original claim 15).

Applicants note the Examiner's previous indication that the "drawings filed 1-23-04 are approved by the examiner." In view of the Examiner's previous approval in view of the same claim language, applicants assert that a final rejection is inappropriate at this time. The applicants have not yet been given an opportunity to respond to the Examiner's objection to the drawings.

Regarding the Examiner's assertion that the drawings do not show an "automatic feed tray", applicants respectfully disagree. As set forth clearly in applicants' specification, "[p]rinting device 10 includes one or more automatic feed media trays 22..." (Specification, page 2, line 32 thru page 3, line 1). As also indicated, "the printing device may include laminate material in one of the automatic feed trays and print media in another automatic feed tray" (Specification, page 4, lines 3-5). The drawings thus clearly do show "an automatic feed tray of the printing device as set forth in claim 9.

Regarding the Examiner's assertion that the drawings do not show an "alternative bypass path", applicants note that such language is not found in the claims. Applicants presume that the Examiner is referring to language in claim 13, which

Page 8 - AMENDMENT  
Serial No. 10/763,352  
HP Docket No. 200209331-1  
KH Docket No. HPCS 327

recites "selectively operable bypass of the image transfer mechanism." As noted in applicants' specification, such bypass (also referred to as "pass through") need not necessarily be mechanical (as the Examiner apparently presumes). Bypass may be achieved "by not charging the composite media, or not scanning the laser across the photoreceptor, or a combination of these" (Specification, page 5, line 31 thru page 6, line 1). The specification has nevertheless been amended to make this more clear.

Based on the foregoing, the objection to the drawings under 37 CFR 1.83(a) should be withdrawn.

#### Claim Rejections

As noted above, claims 1-8, 10-14 and 16-17 stand rejected under 35 USC §103(a). As also noted, the rejections are based on Endo et al. in view of Hooper et al. (and for claims 10-11, in view of "Fukushima"). Applicants respectfully traverse the rejection.

Initially, applicants note that the present Office action newly cites Hooper et al. in rejecting claims 1-8, 10-14 and 16-17. Although the Examiner indicates that applicants' "amendment necessitated the new ground(s) of rejection", it is noted that claims 5 and 13 are substantively unchanged. Claim 5 was amended only to place such claim in independent form. Claim 13 was amended only to incorporate the subject matter of claim 15 (which previously depended from claim 13). The new grounds of rejection for claims 5 and 13 thus were not necessitated by applicants' amendment, and finality of the present Office action should be withdrawn.

Furthermore, applicants note that Hooper et al. qualifies as prior art only under 35 USC §102(e) since it was published and issued after applicants' January 23, 2004 filing date. Additionally, Hooper et al. is assigned to Hewlett-Packard Development

Page 9 - AMENDMENT  
Serial No. 10/763,352  
HP Docket No. 200209331-1  
KH Docket No. HPCS 327

Company, L.P. The subject matter disclosed and the invention claimed in the present application also were, at the time the invention was made, owned by the Hewlett-Packard Development Company, L.P. or subject to an obligation of assignment to Hewlett-Packard Development Company, L.P.

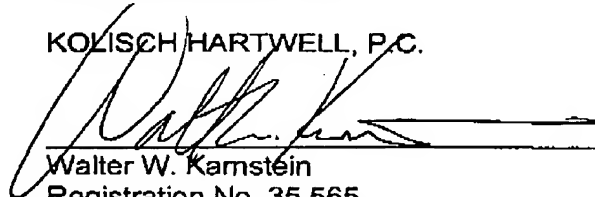
Accordingly, pursuant to 35 USC §103(c), the proposed combination does not preclude patentability, and the rejection under 35 USC §103(a) must be withdrawn.

Conclusion

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner Q. Grainger, Group Art Unit 2852, Assistant Commissioner for Patents, at facsimile number (703) 872-9306 on September 26, 2005.



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Page 10 - AMENDMENT  
Serial No. 10/763,352  
HP Docket No. 200209331-1  
KH Docket No. HPCS 327